

## **REMARKS**

This Response is submitted in reply to the Office Action dated November 2, 2005. Claims 1, 8, 11, 18, 21, 40 and 45 have been amended for the reasons set forth below. No new matter has been added to the Claims. Enclosed is a petition for a one month extension of time to respond to the Office Action and a Terminal Disclaimer, together with a check to cover the cost of such extension and Terminal Disclaimer. Please debit Deposit Account No. 02-1818 for any insufficiency of payment, or credit for any overpayment in connection with this Response.

### **1. Fee Calculation for Claims**

In reviewing the September 12, 2003 Transmittal document for this application, Applicants noticed an error in the fee calculation for the Claims. The Transmittal erroneously stated that the total Claims was forty-two instead of the actual amount of forty-seven. Consequently, the fee calculation did not account for five dependent Claims. However, the Transmittal included a statement authorizing the U.S. Patent and Trademark Office to charge Deposit Account No. 02-1818 for any additional fees required. Applicants respectfully request that the Examiner review this matter and notify Applicants of any additional payment due.

### **2. Priority Claim**

The Office Action stated that, although Applicants' claim for the benefit of a prior-filed application under 35 U.S.C. § 119(e) or under 35 U.S.C. §§ 120, 121, or 365(c) is acknowledged, Applicants have not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1]. Accordingly, the Office Action provided this application with a priority date of September 12, 2003, the filing date of the this application. Applicants do not contest such treatment. The priority claim set forth in the September 12, 2003 Utility Patent Application Transmittal mistakenly designates this application as a continuation application. As set forth in the Filing Receipt and on page 1, lines 5-11 of the Specification, this application is actually a continuation-in-part of U.S. Patent Application No. 10/447,779.

### **3. Double Patenting**

The Office Action rejected: (a) Claim 1 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 10, 17, 22, 26 and 37 of U.S. Patent No. 6,582,306 B2 to Kaminkow ("Kaminkow") in view of U.S. Patent Appln. Pub. No. 2001/004928 A1 to Bennett ("Bennett"); (b) Claims 11, 21 and 40 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 10, 17, 22, 26 and 37 of Kaminkow in view of Bennett; and (c) Claims 30 and 35 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 10, 17, 22, 26 and 37 of Kaminkow in view of Bennett, U.S. Patent Appln. Pub. No. 2003/0027619 A1 to Nicastro, Sr. ("Nicastro") and U.S. Patent No. 6,471,588 to Sakamoto ("Sakamoto").

To advance the prosecution of this application, Applicants have elected to overcome such rejection by submitting the enclosed Terminal Disclaimer. Accordingly, Applicants respectfully submit that they have overcome such rejection.

### **4. Claim Rejections – 35 U.S.C. § 102**

The Office Action rejected Claims 1-5, 7-9, 12, 13, 17-19, 22-25, 27, 31, 32, 36-38 and 41-46 under 35 U.S.C. §102(b) as being anticipated by Bennett. Applicants respectfully disagree with such rejection.

Bennett discloses a stock market game. Bennett's game displays a plurality of images having information about a plurality of companies, such as the XYZ and ABC companies illustrated in Fig. 6 of Bennett. When the player selects one of the companies, Bennett displays a stock exchange floor to the player with a sign of the selected company. In Fig. 7 of Bennett, the player selected company ABC, so the sign of the stock exchange floor bears the name of ABC company. Next, Bennett enables the player to press a "Start Feature" button or a "Sell" button. Bennett states that:

[if] the player presses the "Start Feature" button, a meter 88 is displayed which reflects the current value of the shares. Another meter (not shown) displays the total amount that the player has being the share value multiplied by the number of shares. The signs 86, such as a message 90, begin to change and the two meters will change value by either going up

or down depending on the message displayed. (Bennett, Paragraph [0057]).

Bennett pays the player the total amount displayed when the player presses a "Sell" button or when a fixed time period expires. Bennett's award is thus based on the changing share values of a single company.

Rejected Claims 1-5 and 7-9 depend from independent Claim 1. Un-amended Claim 1 includes, among other elements: a first event associated with a plurality of the symbols; and a second event associated with a mathematical modifier. The Office Action stated that Bennett has a modifier in the form of a multiplier, the current share price multiplied by the number of shares at the end of the bonus game. The Office Action also stated that this ". . . multiplier has a second event associated with it (time period ends or player hits "Sell" button, Para. 54)." Based on Applicants' review, such event of Bennett is not a second event. Paragraph 54 of Bennett describes an event that triggers paying the prize to the player. This event does not trigger, and is not associated with, Bennett's multiplier.

Bennett has a single event which is associated with both the share value and the total amount, and the total amount is the product of the share value and the player's number of shares. Therefore, Applicants submit that Bennett does not disclose a first event associated with a plurality of symbols and a second event associated with a mathematical modifier. On this basis, Applicants respectfully submit that Claims 1-5 and 7-9, excluding the amendments submitted herewith, are not anticipated by Bennett.

Nonetheless, to advance the prosecution of this application, Applicants have amended Claim 1 to clarify the claim language. Amended Claim 1 is generally directed to a gaming device having, among other elements: (a) a plurality of symbols; (b) at least one value indicator associated with each of the symbols, where each of the value indicators displays an initial indication of a starting value, then an indication of at least one intermediate value and then an indication of a final value; and (c) an award based on a plurality of the final values.. In the fourth line of Claim 1, Applicants replaced "a plurality of" with "at least one" to clarify that each of the symbols can be associated with a single value indicator or multiple value indicators.

Bennett does not disclose such combination of elements. As described above, Bennett does not disclose enabling the player to select multiple company symbols and receive an award based on several of the final share values of multiple companies. Accordingly, Applicant submits that Claims 1-5 and 7-9 submitted herewith are in condition for allowance.

Claims 12, 13 and 17-19 depend from independent Claim 11. In making the rejection under 35 U.S.C. §102(b), the Office Action did not address the elements of independent Claim 11. Nonetheless, to advance the prosecution of this application, Applicants have amended Claim 11 to clarify the claim language. Amended Claim 11 is generally directed to a gaming device having, among other elements, an award based on a plurality of final values and a mathematical modifier. In the fourth line of Claim 11, Applicants replaced “a plurality of” with “at least one” to clarify that each of the symbols can be associated with a single value indicator or multiple value indicators. Bennett, as described above, does not include such combination of elements. Accordingly, Applicants submit that Claims 11, 12, 13 and 17-19 submitted herewith are in condition for allowance.

Claims 22-25 and 27 depend from independent Claim 21. In making the rejection under 35 U.S.C. §102(b), the Office Action did not address the elements of independent Claim 21. Claim 21 includes, among other elements: a first selection opportunity enabling a player to select a designated quantity of the symbols to cause a sum of final values to be calculated; and an award determined by applying to a sum, the award modifier associated with a reselected symbol. In the seventh line of Claim 21, Applicants replaced “a plurality of” with “at least one” to clarify that each of the symbols can be associated with a single value indicator or multiple value indicators.

As described above, Bennett’s gaming machine only displays a single total amount associated with the single company selected by the player. Bennett does not disclose causing a sum of final values to be calculated. Also, Bennett’s award is not affected by an award modifier associated with a reselected symbol. Accordingly, Applicants respectfully request the withdrawal of the rejection of Claims 22-25 and 27.

Claims 31-32 depend from independent Claim 30. In making the rejection under 35 U.S.C. §102(b), the Office Action did not address the elements of independent Claim 30. Claim 30 includes, among other elements: indicating a final value in association with each of the selected symbols; enabling the player to reselect at least one of the selected symbols; retrieving a mathematical modifier associated with the reselected symbol; determining an award by performing a mathematical calculation including the indicated final values and the mathematical modifier; and providing the award to the player. As described above, Bennett pays the player the total amount displayed when the player presses a “Sell” button or when a fixed time period expires. Bennett does not disclose enabling the player to reselect the same company. Consequently, Bennett does not disclose retrieving a mathematical modifier associated with a reselected symbol. Furthermore, Bennett does not disclose determining an award based, in part, on such a mathematical modifier. Bennett’s award is not affected by any reselection of a symbol. Accordingly, Applicants respectfully request the withdrawal of the rejection of Claims 31-32.

Claims 36-38 depend from independent Claim 35. In making the rejection under 35 U.S.C. §102(b), the Office Action did not address the elements of independent Claim 35. Claim 35 includes, among other elements: enabling the player to reselect at least one of a first and second symbols; retrieving a mathematical modifier associated with the reselected symbol; determining an award by performing a mathematical calculation including indicated final values and a mathematical modifier; and providing the award to the player. As described above, Bennett does not disclose enabling the player to reselect the same company. Consequently, Bennett does not disclose retrieving a mathematical modifier associated with a reselected symbol. Furthermore, Bennett does not disclose determining an award based, in part, on such a mathematical modifier. Bennett’s award is not affected by any reselection of a symbol. Accordingly, Applicants respectfully request the withdrawal of the rejection of Claims 36-38.

Claims 41-46 depend from independent Claim 40. In making the rejection under 35 U.S.C. §102(b), the Office Action did not address the elements of independent Claim 40. Nonetheless, to advance the prosecution of this application, Applicants have

amended Claim 40 to clarify the claim language. Amended Claim 40 is generally directed to a gaming device having, among other elements, an award based on a plurality of final values. In the fourth line of Claim 40, Applicants replaced "a plurality of" with "at least one" to clarify that each of the symbols can be associated with a single value indicator or multiple value indicators. Bennett, as described above, does not include such combination of elements. Accordingly, Applicant respectfully submits that Claims 40-46 are in condition for allowance.

### **5. Claim Rejections – 35 U.S.C. § 103**

The Office Action rejected Claims 6, 10, 11, 14-16, 20, 21, 26, 28, 29, 34, 39, 40 and 47 under 35 U.S.C. §103(a) as being unpatentable over Bennett in view of Nicastro. Applicant respectfully disagrees with such rejection. These rejected Claims relate to the Claims of this application as follows:

- (a) Claims 6 and 10 depend from Claim 1, amended as described above.
- (b) Claim 11 has been amended as described above, and Claims 14-16 and 20 depend from Claim 11.
- (c) Claims 26, 28 and 29 depend from Claim 21.
- (d) Claim 34 depends from Claim 30.
- (e) Claim 39 depends from Claim 35.
- (f) Claim 40 has been amended as described above, and Claim 47 depends from Claim 40.

Dependent Claims 6, 10, 14-16, 20 and 47 depend from amended Claim 1, 11 or 40. Applicants respectfully submit that such dependent Claims are in condition for allowance for the reasons provided above with respect to amended Claims 1, 11 and 40. Applicants respectfully disagree with such rejection with respect to Claims 26, 28 and 29, 34, which depend from independent Claim 21, and Applicants respectfully disagree with such rejection of Claim 39 which depends from independent Claim 35. For the reasons provided above with respect to independent Claims 21 and 39, Bennett does not disclose, teach or suggest the subject matter defined by any of such

independent Claims. Nicastro discloses a tile game. After the player selects each tile, the player has the opportunity to "take it" or "leave it." Nicastro does not disclose, teach or suggest the subject matter defined by independent Claim 21 or 39. Accordingly, Applicants respectfully request the withdrawal of the rejection of Claims 26, 28, 29, 34 and 39.

The Office Action rejected Claims 30, 33 and 35 under 35 U.S.C. §103(a) as being unpatentable over Bennett and Nicastro in view of Sakamoto. Claims 30 and 35 are each independent, and Claim 33 depends from independent Claim 30. Neither Bennett or Nicastro, as described above, disclose, teach or suggest the subject matter defined by independent Claim 30 or 35. Sakamoto discloses a game machine having a plurality of spinning reels. Based on when the player presses certain stop buttons, the reels spin in one direction, come to a standstill, and then spin in the other direction. Sakamoto does not disclose, teach or suggest the subject matter defined by independent Claim 30 or 35. Therefore, the combination of Bennett, Nicastro and Sakamoto does not disclose, teach or suggest such subject matter. Accordingly, Applicants respectfully request withdrawal of the rejection of Claims 30, 33 and 35.

An earnest endeavor has been made to place this application in condition for formal allowance and is courteously solicited. If the Examiner has any questions regarding this Amendment, the Applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY

  
Renato L. Smith  
Reg. No. 45,117  
Cust. No. 29159

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